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OFFICE OF PETITIONS

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Minneapolis, MN 55440-1022

In re Application of
Merriman, et al.
Application No. 09/577,798
Filed: May 24, 2000
Attorney Docket No. **16113-1341RE9**

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DECISION ON PETITION
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UNDER 37 CFR 1.183
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This is in response to the renewed petition under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.175 filed March 12, 2012, where it requires that a supplemental declaration be executed by the named inventors in a reissue application.¹

The petition is granted.

BACKGROUND

On May 24, 2000, the present application was filed as an application for reissue of U.S. Patent No. 5,948,061 by inventors Merriman and O'Connor who executed an original reissue declaration on August 28, 2000.

During the prosecution of the present application, the Office required a supplemental declaration with a "no deceptive intent" clause for the changes made after a declaration was filed on June 3, 2002.

According to the statements supplied by Nicholas A. Bero together with the documentary evidence, it is established that inventor Merriman has constructively refused to sign the supplemental declaration.

¹ Once an application has received a fully executed oath or declaration that has been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR 1.175(b)(1), requires that:

“For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant.”

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires a supplemental declaration to be signed by all the inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of all the inventors. *See In re Hayes*, 53 USPQ2d 1222 (Comm’r Pat. 1999).

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by an inventor.

The instant petition is accompanied by an appropriate showing that the inventor Merriman has constructively refused to sign the supplemental reissue declaration. Accordingly, the supplemental declaration of March 12, 2012, signed by the remaining joint inventor O’Connor will be accepted as though it was signed by all of the joint inventors as required by 37 CFR 1.175(b)(1) taken in conjunction with 37 CFR 1.172. *See* MPEP 602.02. *See In re Hayes, supra*.

CONCLUSION

The present petition to waive 37 CFR 1.172 is granted.

The application is being forwarded to Technology Center Art Unit 3714 for further prosecution.

Please direct any questions related to this decision to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

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